

### **REMARKS**

This responds to the Office Action mailed on October 4, 2006.

Claims 1, 27, 28, and 48 are amended, no claims are canceled, and claim 49 is added; as a result, claims 1-49 are now pending in this application.

Applicants would like to thank Examiner for a telephone phone interview conducted on January 11, 2007. As a result of the interview, it was agreed that amendments directed to the following objectives overcome the currently cited prior art references:

- 1) amend the claims to clarify that the inventive technique is specific to a health insurance application (as opposed to, e.g., to a life insurance application);
- 2) replace the term "obtaining" in claim 1 with the term "receiving" with respect to an electronic signature;
- 3) clarify that the operation of "obtaining a confirmation" is performed not instead of but in addition to the receiving of the electronic signature;
- 4) specify that the operations of receiving an electronic signature and receiving a confirmation are performed at a server.

Claims 1, 27, and 48, therefore, have been amended to achieve the abovementioned objectives.

#### **Response to §103 Rejection of the Claims**

Claims 1-4, 7, 9-17, 19-29, 32, 34-41, 43-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. (U.S. 2002/0049617) in view of Wolff et al. (U.S. 2002/00929158) and further in view of Hele et al. (U.S. 2002/0116231).

It will be noted that, because the filing date of Hele (August 22, 2002) is later than the filing date of the present application (October 29, 2001), Hele is prior art with respect to the present application only to the extent of the disclosure of the U.S. provisional patent application No. 60/246,260, to which Hele claims priority.

Lencki is focused on improving employer and consumer satisfaction, while confronting the rising costs of employee benefit offerings (Lencki, [0078]). Lencki is directed at offering the line items within a benefit category for purchase by the individual (Lencki, Abstract). Specifically, Lencki teaches the employer determining the minimum benefit package for the company, i.e. health, dental, life, 401(K) etc, and the employee selecting from both upgraded and supplemental benefits from discreet line items, e.g., via an on-line mechanism (Lencki [0082]). Thus, because in Lencki an on-line activity of an employee is related merely to supplemental benefits from discreet line items in conjunction with the minimum benefit package predetermined by the employer, Lencki teaches away from “presenting a user interface to an applicant over the network, the user interface including information pertaining to a medical plan selected by the applicant and facilitating input of application data by the applicant “ and “creating a finalized health insurance application,” as recited in claim 1.

Wolff, on the other hand, is directed at creating an Insurability Documentation File that contains the information needed by underwriters or insurers to evaluate the insurability rating of the prospective insured party (Wolff, Abstract). An Insurability Documentation File, while including secure information, can by no means be regarded as a health insurance application. Rather, it is merely the data used by insurance carriers to evaluate the insurability rating of the prospective insured party. Treating an Insurability Documentation File as a health insurance application would defeat the purpose of soliciting bids from insurers, which is the stated purpose of Wolff (Wolff, [0013]). Thus, Wolff teaches away from “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature” and “transforming the application data into a secure digital file thereby creating a finalized health insurance application,” as recited in claim 1.

The Office action cites Hele to show “presenting a user interface to an applicant over the network, the user interface including information pertaining to a medical plan selected by the applicant and facilitating input of application data by the applicant “ and “creating a finalized health insurance application,” as recited in claim 1. Hele is directed at an overall process for selling life insurance across a network (Hele, Abstract). Thus, Hele fails to disclose

or suggest “creating a finalized health insurance application,” whether considered separately or in combination with Lencki and Wolff.

The Office action cites [0070], [0079], and [0151] of Hele to show “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature,” as recited in claim 1. Hele discloses electronic signatures (Hele, [0070]), a server that produces electronic documents to authenticate the insurance policy (Hele, [0079]), and using a legal electronic authentication method (Hele, [0151]). It is submitted that a process of authenticating of a policy, of a user, or of a signature is not the same as “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature,” as recited in claim 1. For example, the process of authenticating of a signature may result in determining that the signature is authentic, but provide no indication whether the applicant intends to be legally bound by the electronic signature. In contrast, claim 1 requires “obtaining a confirmation from the applicant ... that the applicant intends to be legally bound by the electronic signature.” Claim 1 was amended to spell out that the operation of “obtaining a confirmation” is performed “in addition to the receiving of the electronic signature.”

Because Hele, whether considered separately or in combination with Lencki and Wolff, fails to disclose or suggest at least the features of “obtaining a confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature” and “creating a finalized health insurance application,” as recited in claim 1 as amended, and its dependent claims are patentable in view of the combination of Lencki, Wolff, and Hele and should be allowed.

Claim 27, as amended, recites “a transaction facility ... to ... obtain a confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature, and transform the health insurance application data into a secure digital file thereby creating a finalized health insurance application.” Thus, claim 27, as amended, is patentable in view of the combination of Lencki, Wolff, and Hele and should be allowed for at least the reasons articulated with respect to claim 1.

Claim 27 further recites “a plurality of health insurance carrier devices.” This feature, which was not addressed in the Office action, is not disclosed or suggested by the combination of Lencki, Wolff, and Hele.

Claim 28, as amended, recites “facilitating input of ... a confirmation from the applicant, in addition to the electronic signature, that the applicant intends to be legally bound by the electronic signature” and “an application data processor to transform the health insurance application data into a secure digital file thereby creating a finalized health insurance application.” Thus, claim 28, as amended, and its dependent claims are patentable in view of the combination of Lencki, Wolff, and Hele and should be allowed for at least the reasons articulated with respect to claim 1.

Claim 48, as amended, recites “obtaining a confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature” and “transforming the health insurance application data into a secure digital file thereby creating a finalized health insurance application.” Thus, claim 48, as amended, and its dependent claims are patentable in view of the combination of Lencki, Wolff, and Hele and should be allowed for at least the reasons articulated with respect to claim 1.

Claims 5-6, 18, 30-31, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. (U.S. 2002/0049617) in view of Wolff et al. (U.S. 2002/00929158) and further in view of Hele et al. and further in view of Marchosky (U.S. 2002/029157).

Claims 5-6, 18, 30-31, and 42 include all features of their respective independent claims including the feature of “confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature.” Marchosky is directed at managing medical and biographical records and providing medical diagnoses (Marchosky, [0003]). It was agreed, during the Examiner interview, that at least the feature of “providing the applicant with hyperlinks to portions of the application that have legally binding language,” recited in claim 6, is not present in Marchoski, whether considered separately or in combination with other cited references. Claim 6 is therefore patentable in view of the combination of Lencki, Wolff, Hele, and Marchosky and should be allowed.

Claims 8 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. (U.S. 2002/0049617) in view of Wolff as applied to claims 1 and 28 above, and further in view of Peach (U.S. 2001/0049611). Claims 8 and 33 include all features of their respective independent claims including the feature of “confirmation from the applicant, in addition to the receiving of the electronic signature, that the applicant intends to be legally bound by the electronic signature.” Peach, whether considered separately or in combination with Lencki, Wolff, and Hele, fails to disclose this feature. Claims 8 and 33 are therefore patentable in view of the combination of Lencki, Wolff, Hele, and Peach and should be allowed.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney 408-278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5<sup>th</sup>, day of February 2007.

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